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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,242	10/30/2001	Shigeru Yokono	112857-250	7869

29175 7590 11/27/2006

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EXAMINER	
TRAN, PHILIP B	
ART UNIT	PAPER NUMBER
2155	

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/016,242	YOKONO ET AL.	
	Examiner	Art Unit	
	Philip B. Tran	2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 September 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *27-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *27-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Response to Amendment

1. This office action is in response to the Amendment filed on 09/13/2006. Claim 27 has been amended. Therefore, claims 27-30 are presented for further examination.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 27-29 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Each of claims 27-29 appears to be an abstract idea rather than a practical application of the idea. Each of claims 27-29 does not result in a physical transformation nor does it appear to provide a useful, concrete and tangible result. Therefore, each of claims 27-29 appears non-statutory.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 27-28 are rejected under 35 U.S.C. § 102(e) as being anticipated by Nakashima et al (Hereafter, Nakashima), U.S. Pat. No. 5,930,825.

Regarding claims 27-28, Nakashima teaches a recording medium comprising: a first recording area in which is recorded download identification information for designating information to be downloaded to the recording medium when the recording medium is loaded in a downloading system (= loaded in the optical disk drive 21) [see Nakashima, Figs. 3-4], and medium identification information identifying the recording mediums and a second recording area for recording digital data identified by the download information, wherein the digital data is recorded on the recording medium by the recording system when the medium identification is authorized for recording the digital data, and a third area in which information can be recorded as use record information about various processings executed by the downloading system when the recording medium is loaded in the downloading system to which the recording medium is adapted (= recording medium has a medium ID information storing area in a user data area for identification of the recording medium on which software/data is recorded) [see Abstract and Fig. 23 and Col. 14, Col. 60 to Col. 15, Line 43 and Col. 16, Line 56 to Col. 17, Line 20].

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakashima et al (Hereafter, Nakashima), U.S. Pat. No. 5,930,825 in view of Schoen et al (Hereafter, Schoen), U.S. Pat. No. 5,592,511.

Regarding claim 29, Nakashima does not explicitly teach a fourth area in which information can be recorded as fee record information of fees charged with respect to various processings executed by the downloading system when the recording medium is loaded in the downloading system to which the recording medium is adapted.

However, Schoen, in the same field of recording data on a recording medium endeavor, discloses order/billings information storing on a recording medium [see Schoen, Abstract and Fig. 1 and Col. 3, Lines 8-48]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the teachings of Schoen into the teachings of Nakashima in order to record billings data and protect billings data from unauthorized access.

Regarding claim 30, Nakashima further teaches reading the medium ID and recording data on the recording medium [see Nakashima, Abstract and Col. 2, Lines 11-25]. Nakashima does not explicitly teach the downloading of information based on the download identification information is executed automatically when recording medium is loaded in the downloading system. However, Schoen, in the same field of recording data on a recording medium endeavor, discloses retrieving data information from the remote server and storing on a recording medium [see Schoen, Abstract and Figs. 1 & 3 and Col. 1, Line 63 to Col. 2, Line 9]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the teachings of Schoen into the teachings of Nakashima in order to obtain requested data such as recording songs from the remote server and store on the recording medium.

Response to Arguments

8. Applicant's arguments have been fully considered but they are not persuasive because of the following reasons:

In response to applicant's arguments that cited reference teaches away from the invention of the instant application, the law of anticipation requires that a distinction be made between the invention described or taught and the invention claimed. It does not require that the reference "teach" what the subject patent teaches. Assuming that a reference is properly "prior art," it is only necessary that the claims under consideration "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or "fully met" by it. ***Colman v. Kimberly-Clark Corp.*****, 218 USPO 789.**

Nakashima teaches a recording medium comprising a first recording area in which is recorded download identification information for designating information to be downloaded to the recording medium when the recording medium is loaded in a downloading system (= loaded in the optical disk drive 21) [see Nakashima, Figs. 3-4], and medium identification information identifying the recording mediums and a second recording area for recording digital data identified by the download information, wherein the digital data is recorded on the recording medium by the recording system when the medium identification is authorized for recording the digital data, and a third area in which information can be recorded as use record information about various processings executed by the downloading system when the recording medium is loaded in the downloading system to which the recording medium is adapted. For example, Nakashima discloses recording medium has a medium ID information storing area in a user data area for identification of the recording medium on which software/data is

recorded [see Nakashima, Abstract and Fig. 23 and Col. 14, Col. 60 to Col. 15, Line 43 and Col. 16, Line 56 to Col. 17, Line 20].

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See ***In re Keller*, 642F. 2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck* & Co., 800 F. 2d 1091, 231 USPQ 375 (Fed. Cir. 1986)**. Applicant obviously attacks references individually without taking into consideration based on the teaching of combinations of references as shown in the following section. With respect to Nakashima, applicant seems to argue points the examiner has already construed Nakashima does not explicitly teach while restricting the arguments on the Nakashima-Schoen combined to arguments of no motivation.

Nakashima does not explicitly a fourth area in which information can be recorded as fee record information of fees charged with respect to various processings executed by the downloading system when the recording medium is loaded in the downloading system to which the recording medium is adapted. However, Schoen, in the same field of recording data on a recording medium endeavor, discloses order/billings information storing on a recording medium [see Schoen, Abstract and Fig. 1 and Col. 3, Lines 8-48]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the teachings of Schoen into the teachings of Nakashima in order to record billings data and protect billings data from unauthorized access.

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. See **In re Nomiya, 184 USPQ 607 (CCPA 1975).** *However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art.* See **In re McLaughlin, 170 USPQ 209 (CCPA 1971).** *References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference.* See **In re Bozek, 163 USPQ 545 (CCPA) 1969.** *Every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.* See **In re Bode, 193 USPQ 12 (CCPA 1977).**

In this case, the reason for combining reference Nakashima and Schoen is that to incorporate the teachings of Schoen into the teachings of Nakashima in order to record billings data and protect billings data from unauthorized access.

Therefore, the examiner asserts that cited prior art teaches or suggests the subject matter recited in independent claims. Dependent claims are also rejected at least by virtue of dependency on independent claims and by other reasons shown above. Accordingly, claims 27-30 are respectfully rejected.

Other References Cited

9. The following references cited by the examiner but not relied upon are considered pertinent to applicant's disclosure.

A) Nunokawa et al, U.S. Pat. No. 6,229,882.

B) Sakuma, U.S. Pat. No. 5,731,923.

C) Mizushima et al, U.S. Pat. No. 5,617,263.

D) Dierke, U.S. Pat. No. 6,192,188.

Conclusion

10. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

A SHORTENED STATUTORY PERIOD FOR REPLY TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE MAILING DATE OF THIS ACTION. IN THE EVENT A FIRST REPLY IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CAR 1.136(A) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT, HOWEVER, WILL THE STATUTORY PERIOD FOR REPLY EXPIRE LATER THAN SIX MONTHS FROM THE MAILING DATE OF THIS FINAL ACTION.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tran whose telephone number is (571) 272-3991. The Group fax phone number is (571) 273-8300. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar, can be reached on (571) 272-4006.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Philip Tran

Philip B. Tran
Primary Examiner
Art Unit 2155
November 21, 2006